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MAURNA E. VOLIN*
KEVIN A. KEELING
LYNN M. TERREBONNE, PH.D.
MARC B. BASSLER
WILLIAM C. YOUNGBLOOD*

PATENT AGENTS
MELISSA HANDLER, PH.D.
DANA M. KOLESAR

A.D. CAESAR (1901-1995)
CHARLES RIVISE (1900-1951)

COUNSEL
ALLAN H. FRIED, PH.D.

* ALSO ADMITTED TO PRACTICE IN NJ
† ADMITTED ONLY IN N.J. AND N.Y.

FACSIMILE TRANSMITTAL SHEET

November 10, 2004


TO: Examiner Rena Dye
Grp. Art Unit: 1774*
U.S. Patent and Trademark Office
FACSIMILE NO.: (703) 872-9523
FROM: Martin L. Faigus, Esq.
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FACSIMILE TRANSMISSION CERTIFICATION

I hereby certify that this correspondence (including the attached Response to Advisory Action and Supplemental Declaration of Bruce S. Marks under 37 CFR 1.132) regarding the application identified below, is being transmitted via facsimile to the United States Patent and Trademark Office on November 10, 2004.


Martin L. Faigus, Reg. No. 24,364

First Named Inventor: Bruce S. Marks

Serial No: 09/778,325

Group Art Unit: 1774

Filed: February 7, 2001

Examiner: Lawrence Ferguson

Att. Docket No.: A1019/20268

Confirmation No.: 4861

For: Metallizable White Opaque Films, Metallized films made therefrom and ...

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): BRUCE S. MARKS

Serial No: 09/778,325

Group Art Unit: 1774

Filed: February 7, 2001

Examiner: Lawrence Ferguson

Att. Docket No.: A1019/20268

Confirmation No.: 4861

For: METALLIZABLE WHITE OPAQUE FILMS, METALLIZED FILMS MADE
THEREFROM AND LABELS MADE FROM THE METALLIZABLE FILMSRESPONSE TO ADVISORY ACTIONCommissioner for Patents
Facsimile (703) 872-9523

Sir:

This is responsive to the Advisory Action mailed from the United States Patent and Trademark Office on November 1, 2004, and also confirms a follow-up telephone conference with Examiner Ferguson on November 8, 2004, relating to that Action.

In the Advisory Action Mr. Ferguson's supervisor, Ms. Rena Dye, stated that the Amendment mailed to the PTO on September 30, 2004, raised new issues that would require further consideration, and also stated that the proposed Amendment would not be entered for purposes of Appeal. The Advisory Action incorrectly stated that the Amendment filed by Applicant on September 30, 2004, was in response to a Final Office Action.

The Amendment filed by Applicant on September 30, 2004, and apparently received in the USPTO on October 4, 2004, was in response to a non-Final Office Action, and therefore should have been entered and acted upon.

In the above-identified telephone conference with Examiner Ferguson on November 8, 2004, Mr. Ferguson confirmed that the Amendment filed by Applicant was in response to a non-final Office Action, and stated that an Office Action on the merits would follow shortly.

Application No. 09/778,325
Amendment Dated November 10, 2004
Reply to Office Action of November 1, 2004

In the telephone interview counsel reminded Mr. Ferguson that an interview was conducted in the USPTO among the undersigned counsel, Examiner Ferguson and his supervisor, Ms. Rena Dye, on September 1, 2004. In that interview counsel presented proposed amended claims, and both Examiners acknowledged that the prior art rejections advanced in the previous Office Action would be withdrawn against the claims that were formally submitted in the Amendment mailed to the United States Patent and Trademark Office on September 30, 2004.

Attached as Exhibit A to that Amendment was a Declaration of Bruce S. Marks under 37 CFR. §1.132, which was executed by Mr. Marks on September 24, 2004 (hereinafter "Declaration"). In the Declaration, Mr. Marks explained significant differences between the cold glue adhesives employed in his invention and the cold seal adhesives identified in the prior art. In the Declaration, Mr. Marks stated that cold seal adhesives are a type of pressure-sensitive adhesive, and did not further discuss the properties and functions of pressure-sensitive adhesives, apart from the discussion of cold seal adhesives.

Although, as stated in the Declaration, a cold seal adhesive is tacky and generally bonds to itself through the application of pressure, the specific disclosure of pressure-sensitive adhesives in some of the prior art, e.g., in Swain et al. U.S. Patent No. 4,965,123, refers to adhesives that are not generally characterized as cold seal adhesives. However, as explained in greater detail in the enclosed SUPPLEMENTAL DECLARATION OF BRUCE S. MARKS under 37 CFR. §1.132 (hereinafter "Supplemental Declaration"), although "cold seal adhesives" are not generally referred to as "pressure-sensitive adhesives," people skilled in the art

Application No. 09/778,325
Amendment Dated November 10, 2004
Reply to Office Action of November 1, 2004

understand that they both have common properties and functions that are materially different from the properties and functions of the cold glue adhesives employed in the present invention, and do not have any relationship to such cold glue adhesives. The Examiner's attention is directed to the enclosed Supplemental Declaration for a detailed explanation of facts that support the patentability of the claims now in this application.

In view of the fact that the Amendment and supporting documents mailed to the USPTO on September 30, 2004, were in response to a non-Final Office Action, Applicant respectfully requests that the amendment be entered. In addition, applicant respectfully requests that this Response to Advisory Action and Supplemental Declaration also be entered.

Applicant submits that this application is now in condition for allowance and such action is respectfully requested.


Respectfully submitted,

CAESAR, RIVISE, BERNSTEIN,
COHEN & POKOTILOW, LTD.

November 10, 2004

Please charge or credit our
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to effect entry and/or ensure
consideration of this submission.

By



Martin L. Faigus
Registration No. 24,364
Customer No. 03000
(215) 567-2010
Attorneys for Applicants